

## REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 5-8 and 10-12 are rejected under 35 USC 102(b) over the patent to Walker, et al.

Also, Claim 11 is objected to.

In connection with the Examiner's formal objection to Claim 11, this claim has been amended, and therefore the grounds for its objection should be considered as no longer tenable and should be withdrawn.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicants amended Claim 1, 11 and 12, the broadest independent claims on file, to more clearly define the present invention and to distinguish it from the prior art.

Claim 1 in particular defines that the battery pack has heat-diffusing means include at least one peripherally closed and uninterrupted duct (3, 4) which extends parallel to the longitudinal axes of the battery cells from one axial side to another axial side of the housing, closed off in its entirety from the interior

of the housing in which the battery cells are located, and which open outside at said one and another axial sides for passing a heat-diffusing medium from one axial side to another axial side of the housing between the battery cells.

Turning now to the reference applied by the Examiner, and in particular to the patent to Walker, it can be seen that the battery pack disclosed in this reference has openings (36, 88) which allow a ventilation through the cover of the battery pack. The ventilation is possible along the entire depth of the compartments as explained in column 4, lines 41-43. However, this battery pack, after insertion of the cells, is closed with a bottom cover plate (90) which is attached to the bottom of the main body (10). This bottom cover plate does not have any openings which correspond to the openings provided in the bottom, to allow a passage of a cooling medium, as explained in column 4, line 53 – column 5, line 60.

In contrast, in accordance with applicant's invention the peripherally closed and uninterrupted duct (3, 4) not only extends from one axial side to another axial side of the housing, but is also open outside at said one and another axial sides.

It is believed to be clear that the new features of the present invention which are now defined in Claims 5, 11 and 12 are not disclosed in the patent to Walker.

The Examiner rejected these claims as being anticipated. In connection with this, it is believed to be advisable to cite the decision In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the battery pack disclosed in the patent to Walker does not include each and every element of the present invention as now defined in Claims 5, 11 and 12, and therefore the anticipation rejection applied against the original claims should be considered as not tenable with respect to these claims and should be withdrawn.

The patent to Walker does not contain any hint or suggestion for these features. Therefore, the present invention cannot be considered as obvious because in order to arrive at the present invention from the teaching of the patent to Walker as a matter of obviousness, the battery pack disclosed in the patent to Walker has to be fundamentally modified, by including into it the

new features of the present invention as now defined in Claims 5, 11 and 12. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments it is believed that Claims 5, 11 and 12 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 1, they share its allowable features, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. J. Striker', with a long horizontal flourish extending to the right.

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